

FALK & FISH

ROBERT HARDY FALK, P.C.
RONALD C. FISH, P.C.

G. BYRON JAMISON, SPECIAL COUNSEL

ATTORNEYS AND COUNSELORS
INTELLECTUAL PROPERTY LAW

ATTORNEYS AT LAW
A TEXAS LIMITED LIABILITY PARTNERSHIP

CHATEAU PLAZA
2515 MCKINNEY AVE, SUITE 1565
DALLAS, TEXAS 75201
TELEPHONE (214) 954-4400
FACSIMILE (214) 969-5941
Internet: <http://www.patent.net>
EMail: falk@patent.net

September 26, 2000

OFFICES IN DALLAS, TEXAS
AND SAN JOSE, CALIFORNIA

MAILING ADDRESS
P.O. BOX 794748
DALLAS, TEXAS 75379

#29/14, 3rd
Supl. Statement
of Prior Art

VIA FEDERAL EXPRESS

Examiner Stephen Funk
United States Patent and Trademark
Office Group 2854
Room 9D35- Crystal Plaza IV
Arlington, VA 22202

1-30-01

L. Spruell

Re: *Bill L. Davis, et al*; United States 09/315,796;
Our File No. Will 2501

Dear Examiner Funk:

Enclosed please find Reissue Applicants' Third Supplemental Statement of Prior Art and Other Information concerning U.S. Patent 5,638,752 to Hartung, et al. which came to reissue applicant's attention very recently. Please read this patent carefully prior to the next office action or allowance of the case. I submit also decorations of Williamson, Doughty, Bowyer and expert Prince in support of our position that the '752 patent must be removed as a reference.

Very truly yours,



Robert Hardy Falk

RHF/vm
Enclosure(s)

09345706-051001
TOP SECRET

F.2d 905, 907, 182 USPQ 167, 182 (CCPA 1974); *Ex parte Lemieux*, 115 USPQ 148 (Bd. Of App. 1957).

The derivation is proven and corroborated in the attached declarations of Jesse Williamson (**Exhibit "C"**), Wolstenholme executive Harry Bowyer (**Exhibit "D"**) and Gary Doughty (**Exhibit "E"**). Jesse Williamson and Gary Doughty embarked on a trip to Germany (Doughty Decl. ¶ 2, Williamson Decl. ¶ 3) to try to encourage MAN-Roland to utilize the WIMS process. They were accompanied by Harry Bowyer, an executive with Wolstenholme. After visiting several color separation/boutique color repro companies doing "Hi-Fi" work (Bowyer Decl ¶ 3, Williamson Decl. ¶ 2), they visited MAN-Roland. During the MAN-Roland visit, and seeing a MAN-Roland prototype 706 press with a tower-coater equipped with an anilox roller at end-of-press (Williamson Decl. ¶ 7; Bowyer Decl. ¶ 3) Jesse Williamson suggested the possibility of using the tower-coater with anilox roller "up front" in a lithographic press to the two German MAN-Roland executives at the plant, and Williamson had further discussions about the concept with one of the two Germans at dinner. Williamson Decl. ¶ 7. Doughty and Bowyer each corroborated the assertion of Williamson that Williamson discussed the possibility of going "up front" in the offset lithographic process with a flexographic step in the automobile after the visit. Doughty Decl. ¶ 4, Bowyer Decl. ¶ 3.

Following the trip and the return of Jesse Williamson to the United States, Jesse had further detailed discussions with Bill Davis, who suggested the use of a modified conventional "rack-back." Williamson Decl. ¶ 8.

Bowyer visited reissue applicants' facilities in October 1992 concerning WIMS and the forthcoming IPEX Exhibition and again went over the concept of going "up front" with an anilox flexographic printer/coater. Reissue applicants discussed various ways this could be accomplished – a dedicated station, an auxiliary "rack-back" device or a device like a "T-Head."

The '752 patent appears to pertain to nothing other than the prototype Roland 706 coater seen by reissue applicants Williamson in late May 1992, equipped end-of-press with a tower coater with an anilox roller.

09315796-051301
T08750-96451E60

The '752 discloses in Fig. 3 at Col. 5-6 Williamson's thoughts. It is hornbook law that an inventor's own prior work will not anticipate his later invention unless that prior work is such as to constitute a [§ 102(b)] statutory bar. Chisum, 1 Patents § 3.08 [2] (May, 1988). One can establish derivation other than through the communication of a complete conception. *Hedgewick v. Akers, supra*, 497 F.2d at 908, n. 4 and cases cited therein.

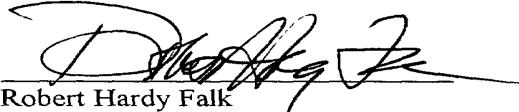
The '752 patent discloses less than what was suggested to the Germans by Jesse Williamson – it doesn't even teach an anilox roller. In fact, it doesn't even discuss an interstation drying step, doesn't discuss the advantages of the invention, or perfecting. According to expert Prince, the '752 patent is clearly non-enabling. Prince Declaration, **Exhibit "F,"** ¶¶ 4-8 and 13-14.

The German Roland team filed a second patent application leading to U.S. Patent 5,476,042 (**Exhibit "G"**) teaching the rest of their coating technology that should have been disclosed in the '752 patent series. The '042 patent teaches that each of the end-of-press coaters can be "convertible" – anilox or not. In view of the '042, the '752 patent is clearly invalid under 35 U.S.C. § 112, 1st paragraph (best mode, lack of enablement).

Examination of various Roland 700 brochures published since 1993 (**Group Exhibit "H"**) shows that Roland never offered in its brochures an anilox roller or other flexo unit "up front" as suggested in Fig. 3 of the '752 Hartung et al. patent. In fact, it appears that Roland first sold its MAN-Roland 700 with the end-of-press double coater in May 1995 (Graphic Arts Monthly, June 1995 at pp. 40 et seq., **Exhibit "I"**).

The testimony of Williamson, Bowyer and Doughty remove Hartung et al. '752 as a reference. *Lemieux, Hedgewick, supra*.

Respectfully submitted,



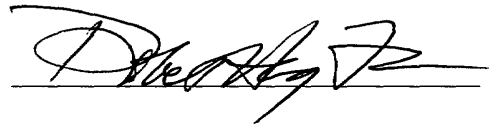
Robert Hardy Falk
Registration No. 27,877
FALK & FISH, L.L.P.
A Texas Limited Liability Partnership
P.O. Box 794748
Dallas, Texas 75397
Telephone: (214) 954-4400
Facsimile: (214) 969-5941

ATTORNEY FOR PETITIONERS BILL L.
DAVIS AND JESSE S. WILLIAMSON

CERTIFICATE OF SERVICE

This is to certify that the foregoing Reissue Applicants' Third Supplemental Statement of Prior Art and Other Information was served on '363 Protectors' and '713 Patentees' counsel of record by placing a true and correct copy in the United States Mail, postage prepaid, on the 27th day of September, 2000, addressed as follows:

William D. Harris, Jr., Esq.
Locke Liddell & Sapp LLP
2200 Ross Avenue, Suite 2200
Dallas, Texas 75201-6776



09345796-051801
FOB150-96/STED